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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,045	03/12/2004	Robert E. Mora	02004 - 0001	8580

7590
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04/09/2007

EXAMINER

SKURDAL, COREY NELSON

ART UNIT	PAPER NUMBER
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3782

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

MT

Office Action Summary	Application No. 10/800,045	Applicant(s) MORA ET AL.	
	Examiner Corey N. Skurdal	Art Unit 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/454,961, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In particular, claims 1-9 are drawn to a caddy that is mounted within a base, the base having a front and rear portion. The prior-filed application 60/454,961 fails to disclose the caddy being mounted within a separate base member, and as such the invention of claims 1-9 will be treated with respect to the filing date of the present application 3/12/2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang (US 2004/0144819).

Regarding claim 1, Huang discloses a multi-functional golf accessory comprising; a base 20 adapted to receive a detachable caddy device 10, wherein said base comprises external storage means 25 and internal storage means within 21; a caddy device 10 adapted to be detachably mounted in loop 35 of the base by detachable clip member 30, and wherein the caddy device further comprises a body adapted and capable to receive any number of devices including a divot repair tool, a golf tee, a golf ball, or other objects related to golf.

Regarding claim 7, the base 20 is disclosed having attachment means 23 for attaching the base to a golf bag or the like.

Regarding claim 8, the caddy device of Huang is considered to include any number edges which may be used as stencils, such as the curved side edge at 11 which one could use to mark a golf ball or the like, in particular noting that no structure has been recited as to what constitutes the stencil.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US 6,220,973).

Regarding claims 10 and 11, Hsu discloses a multi-functional accessory for golfers comprising a caddy device (Figure 1) which is capable of being detachably mountable in a separate base, and wherein the caddy comprises a main body 1 adapted to receive a divot repair device 3, a detachable belt clip 7, golf tees 2, and a stroke counting device 5 (Figure 10) mounted within said caddy device.

Regarding claim 12, the outer surface 510/520 of the Hsu counting device is considered to be substantially spherical, in particular noting that the outer casing is of a substantially similar shape to that of the rings 511 and 512 which Hsu calls semi-spherical (col. 3 lines 6-9). Regarding the stroke counting device being the same dimensions as a golf ball, as no particular dimensions of a golf ball have been recited (i.e. diameter or circumference), Examiner is considering at least some portion of the stroke counting device to have dimension that are substantially the same as a golf ball.

Regarding claim 13, the stroke counting device disclosed by Hsu utilizes mechanical means for counting strokes.

Regarding claim 14, the stroke counting device disclosed by Hsu is considered by Examiner to further constitute a calculator, in that it can be used to add up numbers.

Regarding claim 15, the stroke counting device of Hsu further includes knobs (next to surface 520 in Figure 10), which are used to orient the stroke counting device within the caddy device.

Regarding claim 16, the upper surface of the rotating dial 53 is considered to be a visual display area, wherein the display area is oriented so as to be readable from above when the caddy is clipped to a belt of the user.

Regarding claim 17, the caddy device of Hsu is considered to include any number of stencils, such as the flat top edge at 1 in Figure 1 or the circular ball mark holders at 15, which one could use to mark a golf ball or the like, in particular noting that not structure is recited as to what constitutes the stencil.

Regarding claim 18, Hsu discloses the invention substantially as claimed including a divot repair device 3 including a top region at 3 in Figure 3 and a bottom region at 31 in Figure 3, wherein the top region comprises an aperture through the material of the top region, wherein said aperture is adapted to receive a ball mark 122.

Regarding claim 20, Hsu as applied to claims 10-13, and 16 discloses the claimed invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Flynn (US 6,125,081).

Regarding claim 2, Huang discloses the invention substantially as claimed but does not have a stroke counting device adapted to be mountable within said caddy device. However, Huang does teach that the base 20 and caddy can be used to carry watches, rings or coins (paragraph 13). Flynn teaches a watch to be worn by golfers which has a stroke counting device 14. Therefore it would have been obvious to one skilled in the art at the time of invention to store the watch of Flynn within the caddy of Huang in order to provide the user with a stroke counting device. In doing so, the watch with the counting device would effectively be mounted within the caddy, satisfying the claim.

Regarding claim 3, the watch/counting device of the modified Huang device is considered to be substantially spherical, in particular noting Figure 6, and furthermore, as no particular dimensions of a golf ball have been recited (i.e. diameter or circumference), Examiner is considering at least some portion of the stroke counting device to have dimension that are substantially the same as a golf ball.

Regarding claims 4 and 5, the modified Huang device discloses the invention wherein the stroke counting device is digital and also has a clock.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Kennedy (US 5,393,052). Huang discloses the invention substantially as claimed including a divot repair device D, but does not disclose the divot repair device having an aperture for receiving a removable golf ball marker. However, Kennedy

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teaches a divot repair device including a top region at 50 and a bottom region at 38, wherein the top region comprises an aperture 16 partially through the material of the top region, wherein said aperture is adapted to receive a ball mark, in particular, a dime (col. 5 lines 16-19). Therefore it would have been obvious to one skilled in the art at the time of invention to use the divot repair tool of Kennedy with the Huang device in order to provide a more versatile divot repair tool.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Kennedy (US 5,393,052). Hsu discloses the invention substantially as claimed including a divot repair device 3, but does not disclose the divot repair device having an aperture for receiving a removable golf ball marker, which is a dime. However, Kennedy teaches a divot repair device including a top region at 50 and a bottom region at 38, wherein the top region comprises an aperture 16 partially through the material of the top region, wherein said aperture is adapted to receive a ball mark, in particular, a dime (col. 5 lines 16-19). Therefore it would have been obvious to one skilled in the art at the time of invention to use the divot repair tool of Kennedy with the Hsu device in order to provide a more versatile divot repair tool.

Allowable Subject Matter

10. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey N. Skurdal whose telephone number is 571-272-9588. The examiner can normally be reached on M-Th 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CNS 3/22/07


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER